

**Notice of Allowability**

Application No.

09/973,411

Applicant(s)

CALDWELL ET AL.

Examiner

Venkataraman Balasubramanian

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/03/2003.
2. ☒ The allowed claim(s) is/are 12.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

### **DETAILED ACTION**

Claim 12 is pending.

#### ***Terminal Disclaimer***

The terminal disclaimer filed on 5/8/2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S.S. N 09/973,419 (now US 6,555,684) has been reviewed and is accepted. The terminal disclaimer has been recorded.

### **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

1. Insert before the first line of the specification "This application is a continuation US Serial Number 09/522,117 filed on 03/09/2000."

### REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance:

In view of applicants' response, particularly amendment to claim 12 and assertion based on the Declaration under 37 C.F.R. § 1.132 by Dr. William Caldwell, a) that compounds with an alpha methyl group on the carbon bearing the terminal amine show acceptable binding to the relevant receptors, and b) that such compounds with an alpha methyl group had improved resistance to monoamine oxidase, and therefore, had improved half-lives, and c) that the monoamine oxidase inhibition is observed regardless of the stereochemistry at the relevant carbon (alpha to the terminal amine) as seen in Table 5, and d) that the results of pyridinyl compounds shown in the declaration are equally applicable to the instant pyrimidinyl compound as the pyrimidinyl group is further away from the alpha methyl group involved in the steric effect on monoamine oxidase binding, all prior art 103 rejection over Dull et al., US 5,597,919, is deemed as obviated. In addition, the provisional obviousness-type double patenting rejection over Dull et al., US 5,597,919, is also obviated. Furthermore, applicants' submission of a Terminal Disclaimer has overcome the provisional obviousness-type double patenting rejection over Caldwell et al., U.S.S.N. 09/973,419 now US Patent 6,555,684, made in the previous office action. In addition, the provisional double patenting rejection over U.S.S.N. 08/631,761 is also rendered moot, as applicants have abandoned 08/631,761. Hence claim 12 is deemed as patentably distinct.

The compound of formula 1, with R and S isomer embraced in the instant claim 12 was not found to be anticipated or rendered obvious by the prior art of record.

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Additional search in the related art area also did not yield any prior art disclosing a compound of formula 1, with R and S isomer, embraced in the instant claim. Therefore, the examiner noted that the claim 12 would be in condition for allowance.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### **Conclusion**

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (571) 272-0674. If Applicants are unable to reach Mukund Shah within 24-hour period, they may contact James O. Wilson, Acting-SPE of art unit 1624 at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

*Venkataraman Balasubramanian*  
Venkataraman Balasubramanian

2/18/2004